

PR



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,780	03/07/2002	Jan Anderson	ANJ 001 P2	8727
34232	7590	04/19/2004	EXAMINER	
MATTHEW R. JENKINS, ESQ. 2310 FAR HILLS BUILDING DAYTON, OH 45419			FERNSTROM, KURT	
			ART UNIT	PAPER NUMBER
			3712	10

DATE MAILED: 04/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/092,780

Applicant(s)

ANDERSON ET AL.

Examiner

Kurt Fernstrom

Art Unit

3712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-66 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 16-28 is/are allowed.
- 6) ☒ Claim(s) 1,6-13,15,26,29-31,33,36-47,50,52,57-64 and 66 is/are rejected.
- 7) ☒ Claim(s) 2-5,14,32,34,35,48,49,51,53-56 and 65 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

Art Unit: 3712

DETAILED ACTION

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 15, 29, 30, 45, 46 and 66 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility. The claims as written, recite a single magnetic sheet which is placed over all surface, or all visible surfaces, of a refrigerator to cover the surfaces. If a sheet is so placed, it would not be possible for a user to open the refrigerator. As a result, the claimed invention would render the refrigerator inoperative.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 33 and 43-44 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 33 recites the limitation "said grid pattern" in line 3. There is insufficient antecedent basis for this limitation in the claim, as claim 33 depends from claim 31, which does not recite a grid pattern. Claim 43 recites

a dimension of ".75 r-nm", due to an apparent scanning error. Claim 44 appears to have been cut off in mid-sentence due to an apparent typographical error.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 8-12, 31, 38-42, 47, 50, 52 and 59-63 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders in view of Ojeda. Saunders discloses in Figures 1 and 4 and in column 2, line 44 to column 3, line 11 a system for decorating an appliance such as a refrigerator comprising removable sheet members 24 and 24' having different patterns on them, which are selectively placed on surfaces of the appliance. Saunders fails to disclose the use of a flexible magnet sheet for decorating the surfaces. Ojeda discloses in column 2, lines 8-11 and 45-54 a system of decorating an appliance (in this case, a playhouse) using flexible magnetic sheets to decorate the surfaces of the appliance. Ojeda further discloses in column 3, lines 24-29 that the sheets may be used to cover entire surfaces of the house. It would have been obvious to one of ordinary skill in the relevant art to modify the device and method disclosed by Saunders by providing a flexible magnetic sheet with decorative indicia thereon for the purpose of allowing the user to more easily decorate the appliance. With respect to

Art Unit: 3712

claims 8, 38 and 59, Ojeda discloses in column 3, lines 24-29 that the sheets are "dimensioned and shaped to fit a wall surface". Saunders also discloses that its panels are pre-formed to be placed on the appliance. With respect to claims 11, 12, 40-42, 62 and 63, both single colored and multicolored types of patterns are extremely well known in decorating surfaces, and would have been obvious to one of ordinary skill in the art for the purpose of allowing the user to select a desired pattern for the decoration.

Claims 6, 7, 13, 36, 37, 43, 57, 58 and 64 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saunders in view of Ojeda, and further in view of Nesbitt. Saunders as viewed in combination with Ojeda discloses all of the limitations of claims 6, 7, 36, 37, 57 and 58 with the exception of the various means for placing indicia on the sheet. Each of the claimed means is a well known means of applying indicia to a surface. Nesbitt discloses in column 4, lines 58-63 of the specification a flexible sheet magnet 12 for decorating an object comprising indicia 3, 4, 5 and 8 which are applied to the sheet using painting or silk screening methods. Nesbitt further discloses in column 5, lines 14-41 that a decorative sheet 13 may be laminated onto the magnetic sheet. It would have been obvious to one of ordinary skill in the relevant art to modify the system disclosed by Ojeda by using silk screening, painting or lamination for the purpose of providing decorative indicia on the magnetic sheet. Saunders as viewed in combination with Ojeda discloses all of the limitations of claims 13, 43 and 64 with the exception of the claimed thickness of the sheet. Nesbitt discloses in column 5, lines 42-47 that a thickness of 20 to 60 mils is generally used in its flexible magnetic sheet. It would have been obvious to one of ordinary skill in the relevant art to modify the system disclosed

Art Unit: 3712

by Saunders as viewed in combination with Ojeda by using a sheet magnet with the claimed thickness for the purpose of making the sheet more flexible.

Allowable Subject Matter

Claims 2-5, 14, 32-35, 44, 48-49, 51, 53-56 and 65 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 16-28 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: Essentially, the arguments presented by applicant with respect to these claims are persuasive. With respect to the claims reciting a grid sheet, grid sheets are a well known means of measuring off some material. O. Also, the claims reciting a line of weakness contain allowable subject matter. While Ozgen discloses a flexible magnetic sheet having lines of weakness, Ozgen is specifically directed to coupons, which are detachable from each other via the lines of weakness. There is no motivation to combine Ozgen with the decorative sheets of Saunders or Ojeda, particularly given that the lines of weakness of the present invention are used for folding the sheet, rather than separating individual elements. In this sense Ozgen teaches away from Saunders and Ojeda, since Saunders and Ojeda are directed to sheets which cover entire surfaces.

Response to Arguments

Applicant's arguments filed on December 22, 2003 have been fully considered but they are not persuasive with respect to the rejected claims.

Firstly, applicant is advised that written requests for interviews contained within a response are generally difficult to accommodate. Oftentimes an applicant's response is not reviewed until shortly before the two month deadline for responding. When this happens, it is not possible to contact an applicant to set up an interview time. As it turns out this action is made non-final, in light of the new rejections under 35 USC 101 and 112, so technically applicant did not request an interview prior to the issuance of this action. For future reference, however, applicant is advised to telephone the examiner for an interview if one is deemed necessary.

With respect to the arguments made, the general arguments concerning the Saunders, Ojeda and Nesbitt references are not persuasive. In response to applicant's argument that Ojeda and Nesbitt is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, all three of the references are directed to decorative sheets. Applicant's claims, in particular the apparatus claims, are not directed to an electrical appliance. They are directed to a magnetic sheet. The method claims are directed to a method of using a magnetic sheet. Because Ojeda and Nesbitt both disclose flexible magnetic sheets, which are used to decorate a surface, these references are analogous to applicant's invention.

Art Unit: 3712

Also, because Saunders is directed to decorative sheets for changing the appearance of a refrigerator, the magnetic sheets of Ojeda and Nesbitt are analogous art to Saunders, because both teach improvements over Saunders in the field of decorating a surface. One of ordinary skill in the art would look to various fields where a decorative sheet is attached to a surface, and would not ignore the teachings of Ojeda and Nesbitt simply because the magnetic sheets taught therein are placed on a playhouse and a truck respectively, rather than specifically a refrigerator.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, while Ojeda and Nesbitt do not explicitly discuss the advantages of a flexible magnetic sheet to decorate a surface, such advantages are generally available. The sheets allow a user to easily and conveniently attach a decorative sheet to and remove the decorative sheet from a surface to change the appearance of the surface. Applicant argues that the proposed modification would eliminate the need for the panels and trim of Saunders. In fact, this is an illustration of the motivation to combine the references. The magnetic sheets of Ojeda and Nesbitt do not require trim or other mechanical features to hold the sheets in

Art Unit: 3712

place. This is the primary advantage of a magnetic sheet. The prior art, viewed in combination, suggests the invention of the rejected claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kurt Fernstrom whose telephone number is (703) 305-0303. The examiner can normally be reached on M-F 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on (703) 308-1745. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KF
April 19, 2004

Kurt Fernstrom
Kurt Fernstrom